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OCT 03 2008

**OFFICE OF PETITIONS**

In re Application of	:
Edgar A. O'Rear III, et al.	:
Application No. 10/692,171	:
Filed: October 23, 2003	:
Attorney Docket No.	:
820233.02310	:
Title: METHOD FOR MAKING AN	:
ARTICLE WATER RESISTANT AND	:
ARTICLES MADE THEREFROM	:

This is a decision on the petition filed August 20, 2008,  
pursuant to 37 C.F.R. § 1.137(a), to revive the above-identified  
application.

This petition is **DISMISSED**.

BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. § 1.113 in a timely manner to the final Office action mailed January 10, 2008, which set a shortened statutory period for reply of three months. A Request for Continued Examination (RCE) was received on May 8, 2008,

along with an amendment, however no extension of time under the provisions of 37 C.F.R. § 1.136(a) was requested. Accordingly, the above-identified application became abandoned on April 11, 2008. On May 13, 2008, the Office mailed a "Notice Requiring Extension of Time Fee - No New Time Period is Provided" (notice). A notice of abandonment was mailed on July 31, 2008.

RELEVANT PORTIONS OF THE C.F.R.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

THE APPLICABLE STANDARD

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard:

In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference.<sup>1</sup>

<sup>1</sup> Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources

[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense.<sup>2</sup>

The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'<sup>3</sup>

The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.<sup>4</sup>

Nonawareness of a PTO rule will not constitute unavoidable delay.<sup>5</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application.<sup>6</sup>

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>7</sup>

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Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

2 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

3 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. .706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

4 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

5 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

6 Id.

7 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497 (D.C. Cir. 1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

As such, the general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>8</sup>

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>9</sup>

A delay caused by the mistakes or negligence of a voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.<sup>10</sup>

#### ANALYSIS

A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(1);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the

<sup>8</sup> Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

<sup>9</sup> Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

<sup>10</sup> Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

- reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition, Applicant's attorney has included the petition fee and a statement of facts.

Applicant's attorney has also submitted a three-month extension of time. An extension of time under 37 C.F.R. § 1.136 must be filed prior to the expiration of the maximum extendable period for reply.<sup>11</sup> Accordingly, since the \$ 60 extension of time submitted with this petition on August 20, 2008 was filed subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to the credit card of Applicant's attorney.

The first and second requirements of Rule 1.137(a) have been met. The fourth requirement is not applicable, as no terminal disclaimer is required.

**Regarding the third requirement of Rule 1.137(a),** the record does not support a finding that the entire period of delay was unavoidable.

Applicant's attorney has indicated that he failed to submit the fee that is associated with the filing of a request for a one-month extension of time when submitting the RCE.<sup>12</sup> Applicant's attorney has further indicated that the notice of May 13, 2008 was not received:

"Applicant and Applicant's attorney were never made aware that the one month extension of time had not been paid and thus, the RCE had not been considered. This allowed the application to unavoidably go abandoned due to the fact that Applicant's attorney was awaiting communication from the USPTO."

Petition, page 4.

Applicant's attorney's argument has been considered, and it is not deemed to be persuasive.

First, Applicant's attorney should have been aware that the one-month extension of time fee had not been paid, due to the fact

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11 See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

12 See petition, page 3.

that he submitted neither a request for an extension of time<sup>13</sup> nor the associated fee. It is not understood why, after not submitting either this request or the fee that is associated with the same, he was unaware that he did not submit the one-month extension of time fee.

In regards to the assertion of Applicant's attorney that the Applicant was unaware of this omission, it does not appear that Applicant's attorney has firsthand knowledge of what the Applicant might or might not have been aware of. Nevertheless, the Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of applicants, and applicants are bound by the consequences of those actions or inactions.<sup>14</sup> The actions of an attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him/her, a petitioner cannot later distance himself/herself from this attorney, so as to avoid the repercussions of the actions or inactions of this selected representative, due to the fact that clients are bound by the acts of their lawyers/agents, and **constructively possess "notice of all facts, notice of which can be charged upon the attorney."**<sup>15</sup>

Secondly, the assertion of Applicant's Attorney that this application went abandoned due to the alleged<sup>16</sup> failure of Applicant's Attorney to receive the notice of May 13, 2008 is inaccurate: **this application went abandoned due to the failure of Applicant's Attorney to timely respond to the final Office action. Had Applicant's Attorney included a one-month extension of time along with the submission of the RCE, the RCE would have been considered timely filed, and this application would not have become abandoned - the alleged failure of Applicant's Attorney to receive the notice of May 13, 2008 does not change this fact.**

The entire period of delay might have been unintentional, but the record does not support a finding that it was unavoidable.

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13 The electronic record has been reviewed, and a request for a one-month extension of time (other than the request that was submitted concurrently, with this petition) has not been located.

14 Link v. Wabash, 370 U.S. 626, 633-634 (1962).

15 Link at 633-634.

16 Applicant's Attorney has not established that the notice of May 13, 2008 was not received. A petitioner may establish that a particular Office communication was not received via the process set forth in section 711.03(c)(I)(A) of the MPEP.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(a)".

Applicant's Attorney will note that any showing to establish that the entire period of delay was unavoidable must be directed towards the failure that resulted in the abandonment of this application (the failure to submit a timely reply to the final Office action), as it is the entire period of delay that must be shown to have been unavoidable.

This is not a final agency action within the meaning of 5 U.S.C § 704.

Alternatively, Applicant's Attorney may also file a petition pursuant to 37 C.F.R. § 1.137(b), which carries with it a much lower standard. Unless Applicant's Attorney believes that he can successfully establish that the entire period of delay was unavoidable, he may wish to file pursuant to the unintentional standard.

Applicant's Attorney will note that a third option is to concurrently file both a renewed petition pursuant to Rule 1.137(a) and a petition pursuant to Rule 1.137(b). If the renewed petition pursuant to Rule 1.137(a) is granted, the fee that is associated with the petition pursuant to Rule 1.137(b) will be refunded to him.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,<sup>17</sup> hand-delivery,<sup>18</sup> or facsimile.<sup>19</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>20</sup>

If responding by mail, Applicant's Attorney is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included -

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17 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

18 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

19 (571) 273-8300- please note this is a central facsimile number.

20 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225.<sup>21</sup>

/Paul Shanoski/  
Paul Shanoski  
Senior Attorney  
Office of Petitions

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21 Applicant's attorney will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Applicant's attorney is reminded that no telephone discussion may be controlling or considered authority for any further action(s) by Applicant's attorney.